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09/833,034	04/10/2001	Sudesh Kamath	ORCL5665CIP (OID-2000-128)	8354
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YOUNG LAW FIRM, P.C. 4370 ALPINE RD. STE. 106 PORTOLA VALLEY, CA 94028			VIG, NARESH	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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4       UNITED STATES PATENT AND TRADEMARK OFFICE  
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7       BEFORE THE BOARD OF PATENT APPEALS  
8       AND INTERFERENCES  
9

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11      *Ex parte* SUDESH KAMATH, TYSON HOM, and ALLEN LEE  
12

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13  
14                   Appeal 2008-4623  
15                   Application 09/833,034  
16                   Technology Center 3600  
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18  
19                   Decided: <sup>1</sup> March 18, 2009  
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21  
22      *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN and JOSEPH A.  
23      FISCHETTI, *Administrative Patent Judges*.

24  
25      CRAWFORD, *Administrative Patent Judge*.  
26

27  
28                   DECISION ON APPEAL  
29

30                   STATEMENT OF THE CASE

31      Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection  
32      of claims 1, 3-5, 7, 9-24, 26-28, 30, 32-47, 49-51, 53 and 55-69. We have  
33      jurisdiction under 35 U.S.C. § 6(b) (2002).

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

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2       Appellants invented methods and systems for streamlining and  
3 simplifying the online ordering process while affording the customer and/or  
4 other authorized persons the convenience of modifying or canceling the  
5 order after the initial commitment to order the product has been made  
6 (Specification 4:9-12).

7       Independent claim 1 under appeal read as follows:

- 8           1. A computer-implemented method of  
9 processing an online purchase request from a  
10 customer to a vendor over a computer network,  
11 comprising the steps of:  
12           receiving, over the computer network, a first  
13 online purchase request for a first item;  
14           responsive to receiving the first online  
15 purchase request, providing a bifurcated order  
16 processing route that requests the customer to  
17 choose a first order processing route causing the  
18 first online purchase request to be processed  
19 according to an express processing procedure that  
20 requires no further input by the customer to  
21 execute the first online purchase request, the  
22 second order processing route causing the first  
23 online purchasing request to be placed in a  
24 shopping cart that allows one or more additional  
25 purchase requests for additional items to be placed  
26 therein, the second order processing route  
27 affording the customer an opportunity to cause  
28 execution of the first and any additional purchase  
29 requests placed in the shopping card to be  
30 processed according to the express ordering  
31 processing that requires no further input by the  
32 customer to execute, and

receiving from the customer a selection of the first order processing route or the second order processing route and processing the first online purchase request according to the customer's selection.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Johnson et al. US 5,712,989 Jan. 27, 1998  
Hartman et al. US 5,960,411 Sep. 28, 1999  
Information on Barnes & Noble printed through [www.archive.org](http://www.archive.org)  
wherein date of the archived webpage is in the URL of the webpage in  
YYYYMMDD format (hereinafter “B&N”)

The Examiner rejected claims 1, 3-5, 9-24, 26-28, 32-47, 49-51 and 55-69 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman; and rejected claims 7, 30 and 53 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman and Johnson.<sup>2</sup>

## SUMMARY OF THE DECISION

We sustain the rejections of claims 1, 3<sup>3</sup>, 9-24, 26, 32-47, 49 and 55-69 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman.

We do not sustain the rejections of claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C. § 103(a).

<sup>2</sup> While claims 7, 30 and 52 are initially listed on page 3 of the Examiner’s Answer as only being rejecting in view of B&N and Hartman, page 9 of the Examiner’s Answer admits Hartman does not disclose certain aspects of these claims and further cites Johnson as disclosing those aspects.

<sup>3</sup> Claim 3 depends on cancelled claim 2 which we assume Appellants intended to make dependent on claim 1. Appellants shall in their next correspondence with the Office, make this correction.

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We sustain the rejections of claims 7, 30 and 53 under 35 U.S.C. § 103(a) as being unpatentable over B&N in view of Hartman and Johnson.

3 We also use our authority under 37 C.F.R. § 41.50(b) to enter a new  
4 ground of rejection of claims 4, 5, 27, 38, 50 and 51 under 35 U.S.C.  
5 § 103(a) as being unpatentable over B&N in view of Hartman and Official  
6 Notice

## ISSUES

8        Did the Appellants show the Examiner erred in asserting that the  
9 shopping cart model of B&N could be combined with the single-action  
10 ordering of Hartman to render obvious “the second order processing route  
11 affording the customer an opportunity to cause execution of the first and any  
12 additional purchase requests placed in the shopping card to be processed  
13 according to an express processing procedure that requires no further input  
14 by the customer to execute” as recited in independent claims 1, 24 and 37,  
15 because Hartman teaches away from being used with the shopping cart  
16 model?

17 Did the Appellants show the Examiner erred in asserting that the  
18 shopping cart in B&N corresponds to “a step of enabling the customer to  
19 create a list that includes the first and at least one second item, the list being  
20 persistently stored to enable later retrieval and processing according to the  
21 first or second order process routes” as recited in claims 3, 26 and 49?

22 Did the Appellants show the Examiner erred in asserting that B&N  
23 discloses “the first item includes a uniquely identified and pre-stored list of  
24 goods and/or services” as recited in claims 4, 27 and 50?

25 Did the Appellants show the Examiner erred in asserting that B&N  
26 discloses “wherein the list includes an object, the object including at least  
27 one of another list and item” as recited in claims 5, 28 and 51?

1

## 2 FINDINGS OF FACT

3

### *Specification*

4

Appellants invented methods and systems for streamlining and simplifying the online ordering process while affording the customer and/or other authorized persons the convenience of modifying or canceling the order after the initial commitment to order the product has been made (Specification 4:9-12).

9

A list, according to the present invention, may include any number of items, each predefined or configurable. Lists, according to the present invention, may be ordered following the express ordering procedure and/or placed in a new shopping cart or added to an existing shopping cart that stores other items and/or lists (Specification 21:19-22:9).

14

15

### *B&N*

16

B&N discloses a system for placing an order by selecting an item and adding the item to a virtual shopping cart (B&N 20-21, 36).

18

To make a purchase, a user may click an item they would like to order. They will then be taken to the product page. If they are ordering multiple items or gift wrapping is required, the user will add the item to a cart (B&N 37).

22

The shopper may then choose either Express Checkout or Standard Checkout to order the items in the virtual shopping cart (B&N 37-38).

24

The Express Checkout procedure includes at least clicking on the Express Checkout button, viewing the secure Confirmation Page, and clicking the Place Order button (B&N 37).

27

1

2

3

*Hartman*

4 Hartman discloses a method and system for placing an order for an  
5 item via only a single action (Figs. 1A-1B; col. 3, ll. 46-69).

6 Hartman discloses that although the shopping cart model is very  
7 flexible and intuitive, it has a downside in that it requires many interactions  
8 by the purchaser. If a purchaser is ordering only one item, then the overhead  
9 of confirming the various steps of the ordering process and waiting for,  
10 viewing, and updating the purchaser-specific order information can be much  
11 more than the overhead of selecting the item itself. This overhead makes the  
12 purchase of a single item cumbersome. Also, with such an ordering model,  
13 each time an order is placed, sensitive information is transmitted over the  
14 Internet. Each time the sensitive information is transmitted over the Internet,  
15 it is susceptible to being intercepted and decrypted (col. 2, ll. 27-48).

16 Hartman also discloses a Web page that contains a summary  
17 description section 101, a shopping cart section 102, a single-action ordering  
18 section 103, and a detailed description section 104. The shopping cart  
19 section provides the conventional capability to add the described item to a  
20 shopping cart (col. 4, ll. 4-21).

21

22

*Official Notice*

23 We take Official Notice that bundled software, such as Microsoft  
24 Office Suite, may include multiple software applications such as Microsoft  
25 Excel and Microsoft Word, and that the accompanying packaging or online  
26 description of Microsoft Office Suite includes a listing of the software  
27 applications contained therein.

1

## 2 PRINCIPLES OF LAW

### 3 *Obviousness*

4 “A reference may be said to teach away when a person of ordinary  
5 skill, upon [examining] the reference, would be discouraged from following  
6 the path set out in the reference, or would be led in a direction divergent  
7 from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551,  
8 553 (Fed. Cir. 1994).

9 “[A] combination of familiar elements according to known methods is  
10 likely to be obvious when it does no more than yield predictable results.”

11 *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007).

12 When a work is available in one field of endeavor,  
13 design incentives and other market forces can  
14 prompt variations of it, either in the same field or a  
15 different one. If a person of ordinary skill can  
16 implement a predictable variation, § 103 likely  
17 bars its patentability. For the same reason, if a  
18 technique has been used to improve one device,  
19 and a person of ordinary skill in the art would  
20 recognize that it would improve similar devices in  
21 the same way, using the technique is obvious  
22 unless its actual application is beyond his or her  
23 skill.

24

25 *Id.* at 1740.

26 *Claim Construction*

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1        While the specification can be examined for proper context of a claim  
2 term, limitations from the specification will not be imported into the claims.  
3        *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.  
4 2005).

5           During examination of a patent application, a pending claim is given  
6 the broadest reasonable construction consistent with the specification and  
7 should be read in light of the specification as it would be interpreted by one  
8 of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359,  
9 1364 (Fed. Cir. 2004).

10

11        *Citing References*

12        Where a reference is relied on to support a rejection, whether or not in  
13 a “minor capacity,” there would appear to be no excuse for not positively  
14 including the reference in the statement of rejection. *In re Hoch*, 428 F.2d  
15 1341, 1342 n. 3 (CCPA 1970).

16        Our holdings are based on the references cited. In this sense, said  
17 holdings do not constitute a new ground of rejection. *In re Cowles*, 156 F.2d  
18 551 (CCPA 1946); *In re Christensen et al.*, 166 F.2d 825 (CCPA 1948).

19

20        *Official Notice*

21        Patent Office appellate tribunals, where it is found necessary, may  
22 take notice of facts beyond the record which, while not generally notorious,  
23 are capable of such instant and unquestionable demonstration as to defy  
24 dispute. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970).

25

1 ANALYSIS

2 Hartman discloses several downsides to the shopping cart model (col.  
3 2, ll. 27-48). Appellants argue that this is evidence of a teaching away  
4 (Appeal Brief 22-23). As to the specific question of "teaching away," our  
5 reviewing court in *In re Gurley*, 27 F.3d at 553 stated:

6 A reference may be said to teach away when a  
7 person of ordinary skill, upon [examining] the  
8 reference, would be discouraged from following  
9 the path set out in the reference, or would be led in  
10 a direction divergent from the path that was taken  
11 by the applicant.

12 A careful reading of Hartman discloses that the alleged downsides of  
13 the shopping cart model are really to only certain aspects of one particular  
14 shopping cart model. For example, Hartman disapproves of requiring  
15 "many interactions by the purchaser" and "the overhead of confirming the  
16 various steps of the ordering process and waiting for, viewing, and updating  
17 the purchaser-specific order information can be much more than the  
18 overhead of selecting the item itself" (col. 2, ll. 27-29, 39-43). In another  
19 example, Hartman disapproves of the transmission of sensitive purchaser  
20 information over the Internet (col. 2, ll. 44-48). Indeed, Hartman also  
21 praises the shopping cart model as being "flexible and intuitive" and even  
22 includes shopping cart section 102 on their webpage (Fig. 1A; col. 2, ll. 27-  
23 29; col. 4, ll. 9-12). Accordingly, while Hartman discourages methods and  
24 systems requiring *certain aspects of one particular* shopping cart model,  
25 such as multiple interactions with the purchaser and transmitting sensitive  
26 over the Internet, Hartman does not actually teach away from *every aspect* of  
27 *all* shopping cart models. See *In re Gurley*, 27 F.3d at 553. Thus, as long as

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1 the combination is not directed to the discouraged aspects of the particular  
2 shopping cart model, there is no teaching away.

3       In combining B&N with Hartman, the Examiner is replacing the  
4 multi-step Express Checkout procedure of B&N for the items in a shopping  
5 cart (i.e., clicking on the Express Checkout button, viewing the secure  
6 Confirmation Page, and clicking the Place Order button) with the single-  
7 action ordering of Hartman (Examiner's Answer 4, 11-12). By eliminating  
8 several steps and the transmission of sensitive purchaser information over  
9 the Internet, this combination does not include any of the aspects  
10 discouraged by Hartman. *See In re Gurley*, 27 F.3d at 553. Indeed, the  
11 elimination of these discouraging aspects serves as a motivation for  
12 combining B&N and Hartman. *See KSR Int'l Co.*, 127 S. Ct. at 1740.  
13 Accordingly, the combination of B&N and Hartman in this manner is  
14 proper. The Appellants assert that B&N does not disclose “a step enabling  
15 the customer to create a list that includes the first and at least one second  
16 item, the list being persistently stored to enable later retrieval and processing  
17 according to the first or second order processing routes” as recited in claims  
18 3, 26 and 49. Specifically, the Appellants assert that the shopping cart of  
19 B&N does not meet the definition of a list set forth on page 21 of the  
20 specification, which apparently is limited to a list that counts as only one  
21 item in a shopping cart (Appeal Brief 27-28). As an initial matter, while the  
22 specification can be examined for proper context of a claim term, limitations  
23 from the specification will not be imported into the claims. *CollegeNet, Inc.*  
24 v. *ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005).

25       B&N discloses “[c]lick an item you'd like to order. You'll be taken to  
26 the product page (If ordering multiple items or gift wrapping is required, add  
27 them to your cart.)” (B&N 37) Accordingly, the shopping cart of B&N

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<sup>1</sup> includes multiple items and thus meets the broadest reasonable interpretation of a list. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364.

The Examiner asserts that pages 12, 13 and 37 of B&N discloses “the first item includes a uniquely identified and pre-stored list of goods and/or services” as recited in claims 4, 27 and 50, and “the list includes an object, the object including at least one of another list and item” as recited in claims 5, 28 and 51 (Examiner’s Answer 5). However, none of those pages discloses any of the items in the shopping cart being a list. Page 13 of the Examiner’s Answer speculates that one of the items in the shopping cart of B&N could be bundled software such as Microsoft Office Suite. However, Microsoft Office Suite is first introduced in the Examiner’s Answer and thus must be presented as a new ground of rejection. *See In re Hoch*, 428 F.2d at 1342 n. 3. Compare *In re Cowles*, 156 F.2d at 551; *In re Christensen et al.*, 166 F.2d at 825.

## NEW GROUND OF REJECTION

17 We use our authority under 37 C.F.R. § 41.50(b) to enter a new  
18 ground of rejection of claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C.  
19 § 103(a) as being unpatentable over B&N in view of Hartman and Official  
20 Notice.

21 We take Official Notice that bundled software such as Microsoft  
22 Office Suite may include multiple software applications such as Microsoft  
23 Excel and Microsoft Word, and that the accompanying packaging or online  
24 description of Microsoft Office Suite includes a listing of the software  
25 applications contained therein. *See In re Ahlert*, 424 F.2d at 1091. It would  
26 have been obvious to sell bundled software, such as Microsoft Office Suite,  
27 on online sales systems, such as B&N and Hartman, so as to realize the

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1 advantage set forth in Hartman of reducing the number of steps necessary to  
2 purchase multiple goods. *See KSR Int'l Co.*, 127 S. Ct. at 1740.

3 Accordingly, under this combination, Microsoft Office Suite is a  
4 “uniquely identified and pre-stored list” that meets the recitations of “the  
5 first item includes a uniquely identified and pre-stored list of goods and/or  
6 services” in claims 4, 27 and 50. Furthermore, Microsoft Excel is the “item”  
7 of “at least one of another list and item” recited in “the list includes an  
8 object, the object including at least one of another list and item” of claims 5,  
9 28 and 51.

10

## 11 CONCLUSIONS OF LAW

12 The Appellants have not shown that the Examiner erred in rejecting  
13 claims 1, 3, 9-24, 26, 32-47, 49, and 55-69 under 35 U.S.C. § 103(a) as  
14 being unpatentable over B&N in view of Hartman.

15 The Appellants have shown that the Examiner erred in rejecting  
16 claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C. § 103(a) as being  
17 unpatentable over B&N in view of Hartman.

18 The Appellants have not shown that the Examiner erred in rejecting  
19 claims 7, 30 and 53 under 35 U.S.C. § 103(a) as being unpatentable over  
20 B&N in view of Hartman and Johnson.

21 The Appellants have not shown that the Examiner erred in asserting  
22 that the shopping cart model of B&N could be combined with the single-  
23 action ordering of Hartman to render obvious “the second order processing  
24 route affording the customer an opportunity to cause execution of the first  
25 and any additional purchase requests placed in the shopping card to be  
26 processed according to an express processing procedure that requires no  
27 further input by the customer to execute” as recited in independent claims 1,

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1 24 and 37, because Hartman teaches away from being used with the  
2 shopping cart model.

3       The Appellants have not shown that the Examiner erred in asserting  
4 that the shopping cart in B&N corresponds to “a step of enabling the  
5 customer to create a list that includes the first and at least one second item,  
6 the list being persistently stored to enable later retrieval and processing  
7 according to the first or second order process routes” as recited in claims 3,  
8 26 and 49.

9       The Appellants have shown that the Examiner erred in asserting that  
10 B&N discloses “the first item includes a uniquely identified and pre-stored  
11 list of goods and/or services” as recited in claims 4, 27 and 50.

12       The Appellants have shown that the Examiner erred in asserting that  
13 B&N discloses “wherein the list includes an object, the object including at  
14 least one of another list and item” as recited in claims 5, 28 and 51.

15       We have entered a new rejection pursuant to our authority under 37  
16 C.F.R. § 41.50(b) of claims 4, 5, 27, 28, 50 and 51 under 35 U.S.C. § 103(a)  
17 as being unpatentable over B&N in view of Hartman and Official Notice.

18       37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection  
19 pursuant to this paragraph shall not be considered final for judicial review.”

20       Regarding the new ground of rejection, Appellant must, WITHIN  
21 TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of  
22 the following options with respect to the new ground of rejection, in order to  
23 avoid termination of the appeal as to the rejected claims:

24       (1) *Reopen prosecution.* Submit an appropriate amendment of the  
25 claims so rejected or new evidence relating to the claims so rejected,  
26 or both, and have the matter reconsidered by the examiner, in which  
27 event the proceeding will be remanded to the examiner. . . [; or]

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1           (2) *Request rehearing.* Request that the proceeding be reheard under §  
2           41.52 by the Board upon the same record. . . .

3           No time period for taking any subsequent action in connection  
4           with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

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7           AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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12          LV:

13

14

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